

OCT. 10. 2006 1:52PM LNAPW 512-439-7199

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NO. 9240 P. 4

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REMARKS

The Office Action dated August 10, 2006 has been received and considered. In Reconsideration of the outstanding rejection in the present application is respectfully requested based on the following remarks.

Obviousness Rejection of Claims 1-6, 8, 11-13, 16, 17, 18-20, 23-25, 28-32, 34, 37-39, 42-47, 49 and 52-54

At page 3 of the Office Action, claims 1-6, 8, 11-13, 16, 17, 18-20, 23-25, 28-32, 34, 37-39, 42-47, 49 and 52-54 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Harrison (U.S. Patent No. 5,878,222) in view of Croy et al. (U.S. Patent No. 6,476,825). This rejection is hereby respectfully traversed.

“Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. ‘The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.’” MPEP § 2143.01 (quoting *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)). In this case, there is no motivation to combine Harrison and Croy. Harrison discloses a system for analyzing channel data to determine if channel contents match selection data. *Harrison*, Abstract. In contrast, Croy discloses a control device for controlling and viewing video content. *Croy*, Abstract. Thus, Harrison and Croy are directed to different problems, and there is no teaching, suggestion, or motivation to combine the references, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

The Office Action indicates at pages 4-5 that it would have been obvious to modify Harrison with the teachings of Croy in order to achieve the stated advantage (by Croy) to provide the user with privacy. However, the Office Action does not cite any portion of Harrison to indicate that improved privacy of video content is a desired goal of the Harrison system. Further,

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the Office Action provides no evidence that there is specific understanding or principle within the knowledge of the skilled artisan that would have motivated the combination of the references. *In re Kotzab*, 217 F.3d at 1371. Accordingly, there is no motivation to combine Harrison and Croy.

In addition, each of the claims recites additional novel elements not disclosed or suggested by the combination of Harrison and Croy. For example, claim 39 recites that the content associated with a first portion of television content includes a video clip. These elements are not disclosed by Harrison or Croy. The Office Action alleges that these elements are disclosed by Harrison, because Harrison provides a new channel to pre-empt a current channel, and “the portion of time that the new channel is displayed meets the limitation...of a video clip.” *Office Action*, p. 2. A video clip, as recited in the claim, represents a clipped portion of video content. There is no indication in Harrison that the new channel represents a clipped portion of some larger set of video content. One skilled in the art would not understand providing a new channel to pre-empt a previous one as providing a video clip. Accordingly, Harrison and Croy, individually and in combination, fail to disclose or suggest each and every element of claim 39.

Obviousness Rejection of Claims 9, 10, 21, 22, 35, 36, 50 and 51

At page 6 of the Office Action, claims 9, 10, 21, 22, 35, 36, 50 and 51 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Harrison in view of Croy et al. and further in view of Taylor, Jr. et al. (U.S. Patent No. 6,710,812). This rejection is hereby respectfully traversed. As explained above, there is no motivation to combine Harrison and Croy. Further, Taylor, Jr. does not provide any motivation to combine any of the references. Taylor disclose a news search resultant database containing decoded close captioned news story texts. Thus, Taylor does not address the same problems and issues as the video content system of Harrison and the remote device of Croy. Accordingly, there is no motivation to combine the cited references and therefore no basis for the obviousness rejection. In addition, the claims recite additional novel elements.

In view of the forgoing, it is respectfully submitted that the obviousness rejections of the claims is improper. Withdrawal of the rejections therefore is respectfully requested.

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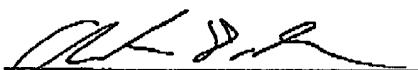
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Conclusion

The Applicant respectfully submits that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

The Commissioner is hereby authorized to charge any fees that may be required, or credit any overpayment, to Deposit Account Number 50-0441.

Respectfully submitted,



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10/10/06
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